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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,482	04/01/2004	Wellen Sham	5088-0002	8505
28777 7590 02/20/2009 MICHAEL L. DIAZ, P.C. 555 REPUBLIC DRIVE, SUITE 200 PLANO, TX 75074				
EXAMINER				
WEST, THOMAS C				
ART UNIT		PAPER NUMBER		
3621				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/815,482

**Applicant(s)**

SHAM, WELLEN

**Examiner**

THOMAS WEST

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the Request for Continued Examination filed on November 28, 2008.
2. Claims 1-53 are currently pending and have been examined.

### ***Claim Rejections - 35 USC §101***

3. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 43 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

In this particular case, claims 1, 43 and their dependent claims 2-18, 35-42 lack sufficient technology. (Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)).

Claims 2-18, 35-42 are also rejected as each depends from either claims 1 or 43. Claim 1 for instance does not recite who is establishing, who determines, who transfers, etc.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-53 are rejected under U.S.C. 103(a) as being unpatentable over Walker, U.S. Patent Application No. 2002/0193162 in view of Schneier, U.S. Patent No. 5,970,143, in view of Bountour, US Patent Application 20020069265.

**Claims 1, 19, 34, 43:**

Walker, as shown, discloses the following limitations:

- establishing a tournament (tournament) having a plurality of rounds (rounds), each round enabling the user to play a game provided by a game server (central controller 102) on the user's communication device (personal computer) through the tournament scheme of play (see at least paragraph 5, 25, 96);

- the game server (central controller 102) being in communication with the communication devices (personal computers) within the network, the game server having a database (tournament database) for recording each game played by the user and a user identification (user ID) identifying the user (see at least paragraph 20)
- the user progressing to a next round (round) upon exceeding a threshold score (threshold) established for the round (see at least paragraphs 44, 98, 99, 175);

Walker discloses the limitations as shown. Walker does not directly disclose the following, but Schneier does:

- determining a fee (fee) to the user for playing each game in the tournament, the fee associated with playing a single game within the tournament (pay-per-game) (col. 6, lines 4-7, col. 33, lines 12-25)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walker to include the per game fee of Schneier since this allows for determining royalties to be paid on a per game basis. .

Walker discloses the limitations as shown. Walker does not directly disclose the following, but Bountour does:

- sending the determined fee (revenue shared) from the game server (game provider) to the network provider (advertiser) (paragraph 5);
- transferring a portion of the revenue (revenue shared) collected by the network provider (advertiser) to the game provider (game provider) based upon playing each game (paragraph 5);

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walker to include the per game fee of Bountour since this allows for revenue sharing with the game provider.

**Claims 2-8, 22-25, 35-38, 46-49:**

Walker, as shown, discloses the following limitations:

- threshold (see at least paragraphs 44, 98, 99, 175);
- next round (see at least paragraphs 44, 98, 99).

**Claims 9, 10, 20, 21, 39, 44, 45:**

Walker, as shown, discloses the following limitations:

- fee per game (see at least paragraphs 86, 104, 106, 113);
- elapsed time (see at least paragraph 20).

**Claims 16, 30, 40, 50:**

Walker, as shown, discloses the following limitations:

- communication protocol (see at least paragraph 36).

**Claims 32, 52:**

Walker, as shown, discloses the following limitations:

- advertising fees charged (see at least paragraph 5).

**Claims 18, 31, 42, 51:**

Walker, as shown, discloses the following limitations:

- points acknowledging ad (see at least paragraphs 112, 185).

**Claims 17, 33, 41, 53:**

Walker, as shown, discloses the following limitations:

- winner and prize (see at least paragraphs 49, 176).

**Claims 11, 12, 13, 26, 27:**

Walker, as shown, discloses the following limitations:

- billing user (see at least paragraphs 49, 176);
- user id (see at least paragraph 20).

**Claims 14, 15, 28, 29:**

Walker, as shown, discloses the following limitations:

- wireless and ISP (see at least paragraphs 25).

***Response to Arguments***

7. Applicant's arguments filed November 28, 2008 have been fully considered but are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the fee associated with playing a single game") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues concerning claim 5, that Walker does not teach a player advancing upon reaching a threshold.. The Examiner respectfully points to paragraph 44 of Walker, where a player advances based on score (threshold). Applicant's further arguments are moot in light of the new grounds of rejection



***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas West whose telephone number is 571-270-1236. The examiner can normally be reached on Tuesday and Wednesday 7:30am - 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas West  
Patent Examiner  
Art Unit 3621  
February 3, 2009

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621